



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

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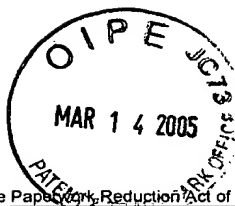
|   |                      |                        |              |
|---|----------------------|------------------------|--------------|
| <b>TRANSMITTAL<br/>FORM</b><br><br>(to be used for all correspondence after initial filing) | Application Number   | 09/819,603             |              |
|   | Filing Date          | March 29, 2001         |              |
|   | First Named Inventor | Gregory W. EASLEY      |              |
|   | Art Unit             | 3713                   |              |
|   | Examiner Name        | J. M. Hotaling         |              |
| Total Number of Pages in This Submission  | 12                   | Attorney Docket Number | 559442001100 |

**ENCLOSURES (Check all that apply)**

|   |  |   |
|---|--|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/<br>Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under<br>37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a<br>Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication<br>to TC<br><input type="checkbox"/> Appeal Communication to Board of<br>Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communication to TC<br>(Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please<br>Identify below):<br>Return Receipt Postcard |
| <b>Remarks</b>  |  |   |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |                         |          |        |
|--------------|-------------------------|----------|--------|
| Firm Name    | MORRISON & FOERSTER LLP |          |        |
| Signature    |                         |          |        |
| Printed name | James M. Denaro         |          |        |
| Date         | March 14, 2005          | Reg. No. | 54,063 |



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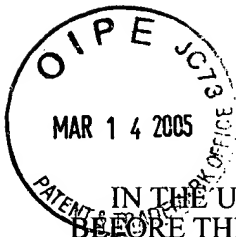
PTO/SB/17 (12-04v2)  
Approved for use through 7/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

|   |  |                          |                      |
|---|--|--------------------------|----------------------|
| <b>FEE TRANSMITTAL</b><br><b>For FY 2005</b>  |  | <b>Complete if Known</b> |                      |
| Effective on 12/08/2004.<br>Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). |  | Application Number       | 09/819,603           |
| <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27                      |  | Filing Date              | March 29, 2001       |
|   |  | First Named Inventor     | Gregory W. EASLEY    |
|   |  | Examiner Name            | John M. Hotaling, II |
|   |  | Art Unit                 | 3713                 |
| TOTAL AMOUNT OF PAYMENT (\$)  |  | Attorney Docket No.      | 559442001100         |
| 500.00  |  |                          |                      |

|   |   |
|---|---|
| <b>METHOD OF PAYMENT</b> (check all that apply)   |   |
| <input type="checkbox"/> Check  | <input type="checkbox"/> Credit Card  |
| <input type="checkbox"/> Money Order  | <input type="checkbox"/> None   |
| <input type="checkbox"/> Other (please identify): _____   |   |
| <input checked="" type="checkbox"/> Deposit Account   | Deposit Account Number: 03-1952   |
|   | Deposit Account Name: Morrison & Foerster LLP                                     |
| For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)                |   |
| <input checked="" type="checkbox"/> Charge fee(s) indicated below   | <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee |
| <input checked="" type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 | <input checked="" type="checkbox"/> Credit any overpayments                       |

|   |                     |   |                    |                      |                                  |                       |                       |
|---|---------------------|---|--------------------|----------------------|----------------------------------|-----------------------|-----------------------|
| <b>FEE CALCULATION</b>  |                     |   |                    |                      |                                  |                       |                       |
| <b>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</b>  |                     |   |                    |                      |                                  |                       |                       |
|   | <b>FILING FEES</b>  |   | <b>SEARCH FEES</b> |                      | <b>EXAMINATION FEES</b>          |                       |                       |
|   |                     | <b>Small Entity</b>                                     |                    | <b>Small Entity</b>  |                                  | <b>Small Entity</b>   |                       |
| <b>Application Type</b>   | <b>Fee (\$)</b>     | <b>Fee (\$)</b>   | <b>Fee (\$)</b>    | <b>Fee (\$)</b>      | <b>Fee (\$)</b>                  | <b>Fee (\$)</b>       | <b>Fees Paid (\$)</b> |
| Utility   | 300                 | 150   | 500                | 250                  | 200                              | 100                   |                       |
| Design  | 200                 | 100   | 100                | 50                   | 130                              | 65                    |                       |
| Plant   | 200                 | 100   | 300                | 150                  | 160                              | 80                    |                       |
| Reissue   | 300                 | 150   | 500                | 250                  | 600                              | 300                   |                       |
| Provisional   | 200                 | 100   | 0                  | 0                    | 0                                | 0                     |                       |
| <b>2. EXCESS CLAIM FEES</b>   |                     |   |                    |                      |                                  |                       |                       |
|   |                     |   |                    |                      |                                  | <b>Small Entity</b>   |                       |
|   |                     |   |                    |                      |                                  | <b>Fee (\$)</b>       | <b>Fee (\$)</b>       |
| Each claim over 20 (including Reissues)   |                     |   |                    |                      |                                  | 50                    | 25                    |
| Each independent claim over 3 (including Reissues)  |                     |   |                    |                      |                                  | 200                   | 100                   |
| Multiple dependent claims   |                     |   |                    |                      |                                  | 360                   | 180                   |
| <b>Total Claims</b>   |                     | <b>Extra Claims</b>                                     | <b>Fee (\$)</b>    | <b>Fee Paid (\$)</b> | <b>Multiple Dependent Claims</b> |                       |                       |
| _____ - 20 = _____  |                     | x   | _____              | =                    | <b>Fee (\$)</b>                  |                       | <b>Fee Paid (\$)</b>  |
| <b>Indep. Claims</b>  |                     | <b>Extra Claims</b>                                     | <b>Fee (\$)</b>    | <b>Fee Paid (\$)</b> |                                  |                       |                       |
| _____ - 3 = _____   |                     | x   | _____              | =                    |                                  |                       |                       |
| <b>3. APPLICATION SIZE FEE</b>  |                     |   |                    |                      |                                  |                       |                       |
| If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s). |                     |   |                    |                      |                                  |                       |                       |
| <b>Total Sheets</b>   | <b>Extra Sheets</b> | <b>Number of each additional 50 or fraction thereof</b> |                    |                      | <b>Fee (\$)</b>                  | <b>Fee Paid (\$)</b>  |                       |
| _____ - 100 = _____   | /50                 | _____ (round up to a whole number) x                    |                    |                      | _____                            | = _____               |                       |
| <b>4. OTHER FEE(S)</b>  |                     |   |                    |                      |                                  |                       |                       |
|   |                     |   |                    |                      |                                  | <b>Fees Paid (\$)</b> |                       |
| Non-English Specification, \$130 fee (no small entity discount)   |                     |   |                    |                      |                                  |                       |                       |
| Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal  |                     |   |                    |                      |                                  | 500.00                |                       |

|                     |                 |                                   |                |
|---------------------|-----------------|-----------------------------------|----------------|
| <b>SUBMITTED BY</b> |                 |                                   |                |
| Signature           |                 | Registration No. (Attorney/Agent) | 54,063         |
| Name (Print/Type)   | James M. Denaro | Telephone                         | (703) 760-7739 |
|                     |                 | Date                              | March 14, 2005 |



PATENT  
Docket No. 559442001100

In re Patent Application of:  
Gregory W. EASLEY et al.

Application No.: 09/819,603

Art Unit: 3713

Filed: March 29, 2001

Examiner: John M. Hotaling, II

For: CONSOLE-BASED SYSTEM AND METHOD  
FOR PROVIDING MULTI-PLAYER  
INTERACTIVE GAME FUNCTIONALITY  
FOR USE WITH INTERACTIVE GAMES

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Washington, D.C. 22313-1450

Sir:

This is a timely appeal from the final rejection of claims 1-21 in the Office Action  
mailed Sept. 13, 2004.

**I. REAL PARTY IN INTEREST**

The real party in interest is ACTV, Inc.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences within the meaning of 37 CFR  
41.37(c)(1)(ii) known to appellant, the appellant's legal representative, or assignee.

**III. STATUS OF CLAIMS**

Claims 1-21 are pending in this application. Claims 1-21 are finally rejected under 35  
USC 102(b) as being anticipated by Rothschild (U.S. Patent No. 6,152,824). The rejection of  
claims 1-21 is being appealed. The appealed claims are reproduced in the attached Appendix.

03/16/2005 JADD01 00000004 031952 09819603

**IV. STATUS OF AMENDMENTS**

No amendment after final rejection has been filed.

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## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claims 1 and 11 are directed to a console game system which provides a central server that provides a backbone layer with a series of services that may be accessed by individual software game modules. The individual software game modules can use the console system for various functions and options. (See p. 5, lines 12-15.)

Services that may be used by several different games may be provided by the server system of the present invention while game specific information may be provided as a separate software game module. (See p. 6, lines 1-3.) Software game modules may be provided at the server or retrieved by the server from a separate location. For example, upon request, the server may retrieve software game modules from other locations or independent sites. The software game modules may send information (*e.g.*, parameters) to the console system to invoke appropriate functionality. The console system may process the information and enable the user to interact with the game application and perform other operations (See p. 6, lines 14-20.)

The claimed invention may provide a flexible system for engaging interactive game applications and other services. The claimed system may provide an application programming interface for games, defining some or all parameters passed by a console system and/or services to a game application and also defining parameters expected in return. As a result, the console system need not know the specifics of the games and their functionality. (See p. 7, lines 12-16.) The claimed system thereby provides a common interface for transparently accessing console system functionality and further provides independence from protocol requirements of the console system.

The console system may provide functions that may be utilized by some or all game applications, whether single-player or multiple-player, for example. The console system of the application may support base components, multiple-player components and independent game components. Other components, functions and/or services may be provided. (See p. 10, lines 4-8.) Thus, the functions and/or services provided through an API with a

common interface are compatible with other software and game applications. (See p. 2, lines 3-11.)

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-21 stand rejected under 35 USC 102(b) as being anticipated by Rothschild (U.S. Patent No. 6,152,824).

**VII. ARGUMENT**

**A. The rejection of claims 1-21 under 35 USC 102(b) should be reversed.**

Claims 1-21 stand rejected under 35 USC 102(b) over Rothschild. Appellant submits that Rothschild does not disclose all of the limitations of independent claims 1 and 11 and therefore also does not disclose the limitations of any dependent claims. Appellant further submits that Rothschild is not relevant to the invention claimed in the pending application. In particular, Rothschild does not disclose systems or methods including a modular system including an application programming interface comprising a common interface for connecting additional modules.

The independent claims of the application recite a “console system” and a “software game module” configured to utilize functionality provided by the console system. The independent claims further recite an “application programming interface” comprising “a common interface for connecting additional modules.” None of these features are taught, disclosed or suggested by the cited reference, Rothschild.

Appellant notes that both independent claims 1 and 11 recite that the console system comprises “one or more base-functionality modules.” As described at p. 3, lines 5-7, of the application, the console system may provide a set of predetermined base-functionality modules that may be leveraged by interactive games provided through various software game modules.

To show the teaching of a console system in Rothschild, the Examiner asserted that “[w]ith respect to one or more consol [sic] systems see columns 4-8 and any reference to game instance class server and game upper level protocol server program.” Appellant submits that there is no teaching in cols. 4-8 -- or anywhere else in Rothschild -- of such a

console system. Columns 4-8 of Rothschild broadly cover communications, encryption, authentication and the selection of certain entities for further communication. This portion of the reference is largely irrelevant to the subject matter of the present application.

Appellant further submits that the Examiner has failed to identify either a “game instance class server” (GICS) or a “game upper level protocol (GULP) server program” as being either the “console system” of the claims or the “base-functionality module” of the claims. Assuming *arguendo* that the GICS or the GULP corresponds to a console system or a base-functionality module, the Examiner has not identified any portion of Rothschild that discloses that the console system, whether in the form of a GICS or GULP, “comprises” a base-functionality module. In fact, the Examiner has not even asserted that Rothschild teaches a base-functionality module. In the office action, the Examiner only made a generalized reference to a console system without reference to the specific features of the claimed console system. Presently pending claims 1 and 11 further recite that the console system comprises a base-functionality module. Because the Examiner has failed to even assert that all of the claimed elements are present in Rothschild, appellant respectfully submits that the Examiner has failed to make a *prima facie* case of anticipation.

Appellant notes that both independent claims 1 and 11 recite an “application programming interface” further comprising “a common interface for connecting additional modules.” This feature was added to the independent claims after the non-final office action mailed Mar. 11, 2004. With regard to claim 1, appellant added the following feature:

at least one application programming interface for the one or more game modules transferring at least one parameter passed by the one or more consoles or servers to the one or more game modules and transferring at least one parameter passed by the one or more game modules to the one or more consoles or servers and wherein the interface further comprises a common interface for connecting additional modules;

A similar feature was added to claim 11. In the final rejection, the Examiner did not expressly address the application programming interface (API) or the claimed feature that it “comprises a common interface for connecting additional modules.” Rather, the Examiner wrote that “[w]ith respect to the amended subject matter please see columns 4-8 which

disclose that the Gizmo (“the client computer upon which the gizmo is running”!!:06-65.[sic]) links to one or more servers and programs to log on and authenticate or to connect to another Master Control Program (MPC) which may represent the type or class of game that is desired.” Appellant respectfully submits that this cited portion of Rothschild does not teach an API with a common interface and that nowhere in the prosecution history has the Examiner even suggested that Rothschild contains such a teaching of an API. The Examiner has merely asserted that Rothschild teaches that a client computer links to a server for log-on or authentication or connects to another entity representative of a type or class of game. The office action fails to show that the reference discloses an API and thereby also fails to show that the API comprises the additional feature of a common interface for connecting additional modules. Because the Examiner has not asserted that these claimed features are present in the prior art, appellant respectfully submits that the Examiner has failed to make a *prima facie* case of anticipation.

As discussed above, the specification of the application describes that the console system “may be ignorant of the games and their functionality, and focus on the parameters supplied.” (See p. 7, lines 12-16.) The ability of the console system to be ignorant of the games and their functionality is a result of the “common interface for connecting additional modules” of claims 1 and 11. The claimed system thereby provides a common interface for transparently accessing console system functionality and further provides independence from protocol requirements of the console system. This claimed common interface overcomes certain problems of the prior art typified by Rothschild. As described in the Background of the Invention section of the application at p. 2, “[g]enerally, client-side game systems are inflexible and difficult to upgrade. Oftentimes, an entire new client-side system is required to adapt to advances in graphics, sound quality, and other improvements and enhancements. Also older cartridges may not be compatible with newer (e.g. upgraded) client-side systems.” Additionally, in the prior art systems, each game application typically provides options and services that are exclusively associated with a particular game application. These options and services are generally not compatible with other software and game applications. Rothschild

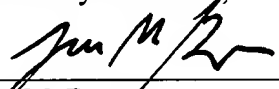
does not overcome these limitations of the prior art because it does not teach a common interface for connecting additional modules.

Appellant respectfully submits that there is no disclosure in the cited prior art of an API comprising a common interface for connecting additional modules. Because the Examiner has not shown that Rothschild teaches anything more than a modularized system for playing a game over a network, the final rejection of claims 1-21 should be reversed.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, appellant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 559442001100.

Dated: March 14, 2005

Respectfully submitted,

By   
James M. Denaro  
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(703) 760-7739



## **APPENDIX OF APPEALED CLAIMS**

1. A system for providing functionality to remote users at individually addressable systems, the system comprising:
  - one or more servers in communication with one or more remote user systems wherein the remote user systems are individually addressable;
  - one or more console systems operating on the one or more servers wherein the console systems comprise one or more base-functionality modules; and
  - one or more software game modules that utilize functionality provided by the console system to provide interactive game content to the remote user system;
  - at least one application programming interface for the one or more game modules transferring at least one parameter passed by the one or more consoles or servers to the one or more game modules and transferring at least one parameter passed by the one or more game modules to the one or more consoles or servers and wherein the interface further comprises a common interface for connecting additional modules;
  - wherein one or more parameters are received from the remote user system at the console system;
  - wherein the software game module passes game-specific information to the console system; and
  - wherein the console system communicates with the remote user system using a base-functionality module in a manner determined by the game-specific information.
2. The system of claim 1 wherein the console system is in communication with one or more multi-player functionality modules.
3. The system of claim 1 wherein the console system is in communication with one or more game service modules.
4. The system of claim 1 wherein the base functionality modules comprise one or more of registration module, prize module, email module, notification module, reporting module, and system/error module.

5. The system of claim 2 wherein the multi-player functionality modules comprise one or more of chat module, ping module, style functionality, gateway module, lobby module, game selection module, and game server module.

6. The system of claim 3 wherein the game service modules comprise one or more of trivia module, fantasy module, predictive module and chat for single play module.

7. The system of claim 2 wherein the multi-player functionality module comprises a gateway module that generates a list of games and player data.

8. The system of claim 2 wherein the multi-player functionality module comprises a lobby module that contains game data, player data, menu options, and chat functionality.

9. The system of claim 1 wherein the interactive game content comprises a real-time event displayed on the remote user system.

10. The system of claim 9 wherein the remote user system comprises one or more of television, digital television, computer monitor, and wireless device.

11. A method for providing functionality to remote users at individually addressable systems, the system comprising the steps of:

communicating with one or more remote user systems wherein the remote user systems are individually addressable;

operating a remote console system wherein the console system comprises one or more base functionality modules;

providing interactive game content to the remote user system via a software game module that utilizes one or more base functionality modules;

passing at least one parameter through an application programming interface defining at least one parameter passed by the console system to the game module and defining at least one parameter passed by the game module to the console system and wherein the interface further comprises a common interface for connecting additional modules; and

communicating one or more parameters from the remote user system to the console system;

wherein the software game module passes game-specific information to the console system; and wherein the console system communicates with the remote user system using a base-functionality module in a manner determined by the game-specific information.

12. The method of claim 11 wherein the console system is in communication with one or more multi-player functionality modules.

13. The method of claim 11 wherein the console system is in communication with one or more game service modules.

14. The method of claim 11 wherein the console system is operating at a central server.

15. The method of claim 11 wherein the base functionality modules comprise one or more of registration module, prize module, email module, notification module, reporting module, and system/error module.

16. The method of claim 12 wherein the multi-player functionality modules comprise one or more of chat module, ping module, style functionality, gateway module, lobby module, game selection module, and game server module.

17. The method of claim 13 wherein the game service modules comprise one or more of trivia module, fantasy module, predictive module and chat for single play module.

18. The method of claim 12 wherein the multi-player functionality module comprises a gateway module that generates a list of games and player data.

19. The method of claim 12 wherein the multi-player functionality module comprises a lobby module that contains game data, player data, menu options, and chat functionality.

20. The method of claim 11 wherein the interactive game content comprises a real-time event displayed on the remote user system.

21. The method of claim 19 wherein the remote user system comprises one or more of television, digital television, computer monitor, and wireless device.